



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/923,783	09/04/97	ROSER	B 263742001001

SUSAN K LEHNHARDT
MORRISON & FOERSTER
755 PAGE MILL ROAD
PALO ALTO CA 94304-1018

HM22/1102

EXAMINER

SAUCIER, S

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 11/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/923,783

Applicant(s)

Roser et al.

Examiner

Sandra Saucier

Group Art Unit

1651



☒ Responsive to communication(s) filed on Sep 3, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10, 12, 13, 15-23, 26-42, 44-49, 54-59, 61-67, 69-72, and 78-97s/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10, 12, 13, 15-23, 26-42, 44-49, 54-59, 61-67, 69-72, and 78-97 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1651

DETAILED ACTION

Claims 1-10, 12, 13, 15-23, 26-42, 44-49, 54-59, 61-67, 69-72, 78-97 are pending and under examination. Please note the error made on the front page of the action mailed 6/8/99 where pending claims 12-22 were omitted from the list. Please check your records to ensure proper claim pendency. A clean copy of the pending claims would be appreciated.

Please note that claims 73 and 75 were canceled on page 2 of the amendment filed 9/3/99. New claims 73 and 75 were requested to be entered in this same paper, but were not entered because they were requested to be canceled. Therefore, Claims 73 and 75 are not pending and the subject matter of claims 73 and 75 is not now present in the case.

Claim Rejections – 35 USC § 112

Claims 1 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has an improper Markush group. The phrase is "selected from the group consisting of", not "selected from the group comprising".

Claim 17 depends on a canceled claim. Please correct.

Claim 70 is not understandable. The repetitive use of the word "material" makes the claim confusing. A suggestion follows.

70. A method for dissolving a foamed glass matrix which incorporates a biologically active agent comprising contacting the foamed glass matrix with sufficient solvent to dissolve the foamed glass matrix and biologically active agent.

Does the definition of an FGM in the specification include a biological agent or does the FGM have to contain only a sugar. It appears from reading the publications, that a FGM may be formed only from sugar. A foamed glass matrix is a state of matter which may be formed solely from a glass-forming compound. The instant claims are directed to foamed glass matrices which have a biological agent incorporated into them. It is suggested that the independent claims be amended to clarify this point. For example, the

Art Unit: 1651

preamble to claim 1 might contain the phrase "foamed glass matrices containing a biologically active agent", and the final sentence of the claim state "produces a foamed glass matrix containing the biologically active agent".

Please also amend the composition claim 71 to reflect that the FGM has a biological material incorporated into it.

Claim Rejections - 35 USC § 102

Claims 62, 63, 65-66, 70, 72, 83, 85, 87, 90, 91, 93, 96 and 97 remain/are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5030469 [1] as explained in the previous office action.

With regard to the exact % of residual moisture, the reference is silent. However, because the active steps of the claimed method are the same as the method of '469, it is assumed that the product of '469 has the same residual moisture in the absence of evidence to the contrary. This would reasonably be expected to be an inherent property of the product produced by the method of '469.

Claim Rejections - 35 USC § 103

Claims 69, 90, 92, 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5030469 [1] in combination with US 5516763 [A27] or US 5262191 [B27] or Postavaru [U27].

The substitution of lactitol or trehalose (claims 92, 95) for the generic disclosure of 'sugar' or glucose in the method of '469 would have been obvious when '469 was taken with US 5516763 or US 5262191 which demonstrate that lactitol or trehalose are used in the candy making field.

The dissolving of the product of claim 65 comprising contacting the FGM with a solvent would have been obvious when US 5030469 was taken into consideration because candy containing a flavoring is usually dissolved while being eaten and digested.

The addition of a volatile foaming agent in the method of '469 to the non-limiting list of foaming agents mentioned (col. 1, l. 20) would have been obvious when '469 was taken with Postavaru [U27] who discloses the use of compressed air, which is a volatile foaming agent, in the foaming of

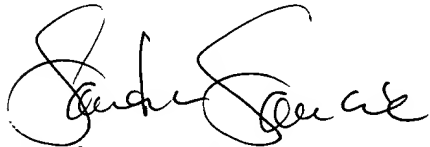
Art Unit: 1651

confections. The use of nitrogen gas, which is also volatile, is also known in the confection field.

Claim 1 and claims dependent on claim 1 appear to be directed to allowable subject matter.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. Status inquiries must be directed to the Service Desk at (703) 308-0196. The number of the Fax Center for the faxing of papers is (703) 308-4227.

A handwritten signature in black ink, appearing to read 'Sandra Saucier', with a stylized, cursive script.

Sandra Saucier
Primary Examiner
Art Unit 1651
November 1, 1999